

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

AUG 6, 97

Paper No. 11  
GDH/KRF

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Lucrecia  
v.  
Physicians Aesthetic Research, Inc.

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Cancellation No. 23,919

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Mofid Bissada for Lucrecia.

Walter A. Hackler, Esq. for Physicians Aesthetic Research, Inc.

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Before Sams, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

A petition has been filed by Lucrecia to cancel the registration owned by Physicians Aesthetic Research, Inc. for the mark "LUCRÈCE" and design, as reproduced below,



for "skin care products; namely, skin clarifiers, cleaning creams, emollients, moisturizers, toners and soap; hand cream, cold cream, lip gloss, lipstick, make-up, rouge, body creams and body powders and wrinkle removing skin care lotions, creams and moisturizers."<sup>1</sup> As "THE GROUND FOR CANCELLATION," petitioner alleges the following:

1- REGISTRANT PERSISTENTLY USES THE NAME "LUCRECE" ON THEIR PRODUCT LABEL NAME AS AN IDENTIFICATION OF THE BRAND IN LIEU OF: PHYSICIANS['] AESTHETIC RESEARCH LUCRECE.

2- REGISTRANT ADVERTISE[S] THEIR PRODUCTS THRU [sic] POINT OF PURCHASE DISPLAY AS WELL AS CONVENTION/EXHIBIT AS "LUCRECE" CREATING A CONFUSION WITH RETAILER'S [sic] AS WELL AS THE ULTIMATE USER/CONSUMER.

3- SIMILARITY BETWEEN "LUCRECIA" AND "LUCRECE" IS VERY CLOSE IN SOUND AS WELL AS SPELLING TO BE USED UNDER THE SAME TRADE CLASSIFICATION AWARDED UNDER THE U.S. CLASS 051 052 INT'L CLASS 003.

4- REGISTRANT IS AWARE OF "LUCRECIA'S" EXISTENCE AND USED THE NAME OF "PHYSICIANS['] AESTHETIC RESEARCH LUCRECE" IN ORDER TO OBTAIN A U.S. TRADEMARK REGISTRATION WITHOUT ANY POSSIBLE OBJECTION AND THEN DECIDED TO USE LUCRECE AS A BRAND NAME AFTER BEING AWARDED A REGISTRATION FROM THE U.S. TRADEMARK [OFFICE,] DISREGARDING THE ACTUAL NAME OF THE REGISTRATION PHYSICIANS' AESTHETIC RESEARCH LUCRECE.

5- PETITIONER IS HEREBY REQUESTING CANCELLATION OF THE SAID NAME LUCRECE FROM THE REGISTRATION IN ORDER TO ELIMINATE ANY FURTHER CONFUSION INTENDED DIRECTLY OR INDIRECTLY TOWARDS THE CONSUMER [AND] THUS

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<sup>1</sup> Reg. No. 1,868,806, issued on December 20, 1994 from an intent-to-use application filed on August 2, 1993, which sets forth dates of first use of August 19, 1993.

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DISALLOWING THE REGISTRANT FROM THE USE OF  
THE NAME "LUCRECE" AS A WHOLE OR AS A PART OF  
A BRAND OR PRODUCT IDENTIFICATION.

Respondent, in its answer, "admits the allegations" set forth in the first numbered paragraph of the cancellation petition, "admits that copies of documents purporting to be [its] product advertisement[s] were appended to the Petition to Cancel" and "admits [its] awareness of the existence of LUCRECIA." Respondent, however, denies the remaining allegations comprising the petition for cancellation.<sup>2</sup>

The record consists of the pleadings; the file of the involved registration; and a "STATEMENT OF UNCONTESTED FACTS," with accompanying exhibits, filed by petitioner during its initial testimony period.<sup>3</sup> Neither party took testimony, nor did

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<sup>2</sup> Although respondent's answer also contains an "AFFIRMATIVE DEFENSE" which, among other things, alleges that "[t]here is no likelihood of confusion, mistake or deception of the purchasing public, [as] between Registrant's mark and the Petitioner's name, LUCRECIA, when considered in their entirety" and that "[a]ll products sold by Physicians' Aesthetic Research, Inc. includes [sic] the registered mark imprinted on bottles as exhibited in the attached product description, see Exhibit 'A'," such allegations simply constitute amplifications of respondent's denials rather than, strictly speaking, an affirmative defense.

<sup>3</sup> The Board, noting that it was "unclear" whether petitioner actually served a copy of such papers on counsel for respondent, indicated in an order issued on April 11, 1996 that it had "contacted counsel for respondent to see if respondent had received petitioner's papers and was informed that respondent had received them." Respondent, however, never seasonably moved to strike petitioner's statement and/or any of the accompanying exhibits and, thus, implicitly stipulated to the introduction thereof into the record under Trademark Rule 2.123(b), which in relevant part provides that "the facts in the case of any party may be stipulated." Instead, after the close of trial, respondent in its brief states that it "objects to [the] admissibility of Petitioner's Exhibit A," which consists of a printout of the "Trademark Registration File" for Reg. No. 1,745,032 (issued on January 5, 1993 for the mark "LUCRECIA" for perfume and certain cosmetic preparations for the care of the skin), "on the ground that it is incompetent as evidence in this proceeding" and therefore "should be stricken." We find, however, that by

respondent offer any evidence. Briefs have been filed, but an oral hearing was not requested.

Preliminarily, there is a question as to what ground or grounds, if any, were pleaded and/or tried in this proceeding.<sup>4</sup> Respondent, in its brief, argues that "the only ground that can be properly considered by the Board is the ground of likelihood of confusion." While respondent, in particular, asserts that petitioner "has pleaded the ground of likelihood of confusion," we note that a pleading of likelihood of confusion, without a corresponding pleading of priority of use, fails to state a ground or claim upon which relief can be granted. Moreover, although petitioner alleges in the cancellation petition that it is respondent's use of the name "LUCRÈCE" alone, that is, without the design elements and the words "PHYSICIANS' AESTHETIC RESEARCH," which is likely to cause confusion with petitioner's use of the mark "LUCRECIA," the name "LUCRÈCE" itself is not the subject of respondent's involved registration, which is for the mark "LUCRÈCE" *and design*.<sup>5</sup> In fact, petitioner admits in its

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failing to raise such objection earlier, respondent has waived its objection to the extent that exclusion of petitioner's Exhibit A from the record is sought. Accordingly, petitioner's statement of uncontested facts and the exhibits attached thereto, including Exhibit A, form part of the record herein for whatever probative value such evidence may have.

<sup>4</sup> In this regard, Fed. R. Civ. P. 15(b), which is made applicable herein by Trademark Rule 2.120(a), provides in relevant part that "[w]hen issues not raised by the pleadings are tried by express or implied consent of the parties, they shall be treated in all respects as if they had been raised in the pleadings."

<sup>5</sup> Likewise, at trial, petitioner asserts in the statement of uncontested facts that "[t]he similarity of 'LUCRECIA' & 'LUCRECE' is so close in spelling and pronunciation as well as looks that it creates a [likelihood of] confusion with the consumer." Petitioner

initial brief that "the respondent can and without any infringements use the name as it has been granted by the United States Trademark Office[:] 'PHYSICIANS['] AESTHETIC RESEARCH LUCRECE" and concedes in its reply brief that "there is no likelihood of confusion between the Registrant['s] Word Mark ['PHYSICIANS' AESTHETIC RESEARCH LUCRECE'] and the Petitioner['s] Word Mark 'LUCRECIA'".

In consequence of the above, we find that there is no pleading by petitioner of the ground or claim of priority of use of its mark "LUCRECIA" and likelihood of confusion from contemporaneous use by respondent of its registered mark "LUCRÈCE" and design, nor was such a ground or claim tried by the express or implied consent of the parties. Furthermore, even if petitioner intended to plead and try the ground of priority of use and likelihood of confusion as to its mark "LUCRECIA" and the name or word mark "LUCRÈCE," such a claim is not cognizable in the proceeding since, as previously mentioned, respondent's registered mark is for the mark "LUCRÈCE" *and design* rather than just the word mark "LUCRÈCE".

A generous reading of the allegations of the petition for cancellation<sup>6</sup> reveals, however, that although inartfully pleaded in the extreme, petitioner has alleged abandonment by

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additionally notes therein that "the Trademark was not granted to [the mark] 'LUCRECE' but to [the mark] 'Physicians['] Aesthetic Research Lucrece," that is, the mark "LUCRÈCE" and design.

<sup>6</sup> As made applicable to this proceeding by Trademark Rule 2.120(a), Fed. R. Civ. P. 8(f) provides that "[a]ll pleadings shall be so construed as to do substantial justice."

respondent of its registered mark "LUCRÈCE" and design, due to intentional nonuse thereof, as a ground or claim for cancellation. In essence, petitioner alleges in the cancellation petition that respondent, subsequent to obtaining its involved registration, ceased use of the mark "LUCRÈCE" and design with the intent not to resume such use and, instead, used only the name or word mark "LUCRÈCE" alone. When such allegations are read in conjunction with petitioner's allegations of its standing to bring this proceeding, in that its name or mark "LUCRECIA" is confusingly similar to the term "LUCRÈCE" in respondent's "LUCRÈCE" and design mark, the petition for cancellation sets out a claim of abandonment as the ground for cancellation.

Petitioner's initial brief confirms that abandonment, rather than or in addition to any possible claim of priority of use and likelihood of confusion, is the sole ground upon which the cancellation petition is intended to be based. Petitioner, in its initial brief, argues that respondent, "by altering the Trademark No. 1,868,806 and admitting the changes on answer," namely, that it is using the term "LUCRÈCE" on its product labels, has thus "in fact abandon[ed] the usage of the Trademark ["LUCRÈCE" and design]." In particular, petitioner states in the final paragraph of such brief that:

11- The Petitioner does not have any objection [to] the way the name is originally registered and its usage in commerce [by respondent] ... without any alterations ... [but respondent] must not use the name "LUCRECE" on the product packaging alone and [its] use must be exactly as shown and applied for to the U.S. Trademark

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registration office[:] "PHYSICIANS[']  
AESTHETIC RESEARCH LUCRECE". Any alteration  
is an abandonment to the original  
registration.

Although respondent, in its brief, contends that petitioner "belatedly" has "raised the ground of abandonment ... for the first time during this final hearing," we disagree. While, as indicated previously, the petition for cancellation is far from a model of clarity in terms of setting forth abandonment as the ground on which the petition is predicated, the following statements by petitioner in its statement of uncontested facts are enough to have alerted respondent that petitioner actually was asserting and attempting to prove a claim of abandonment of the registered mark "LUCRÈCE" and design:

In view of the foregoing, the Petitioner contends that his petition to cancel is based on the fact that the Registrant was never granted a registration for the usage of the word "Lucrece" in their trademark registration No. 1,868,806.

Petitioner believes that the Registrant should not alter the Trademark registration name as it was granted to them by The United States Patent and Trademark Office, and if they choose to alter the name then the petition to cancel should be granted and enforced.

Respondent, in short, had sufficient notice during trial that petitioner was pursuing a claim of abandonment as its ground for cancellation and thus, if respondent desired to do so, it could have presented evidence, which would clearly be within its own knowledge and possession, that it had not ceased use of the "LUCRÈCE" and design mark with no intent to resume use, that is,

that it had not abandoned its registered mark. Accordingly, inasmuch as respondent has not been prejudiced, and since in any event respondent in its brief has argued the merits of petitioner's abandonment claim, the only issues pleaded and tried in this case, and which we must now determine, are whether petitioner has standing to bring this proceeding and whether respondent has abandoned its "LUCRÈCE" and design mark.

Petitioner, in its statement of uncontested facts, lists as established thereby the following:

1- Petitioner is doing business as LUCRECIA and have [sic] a Trademark Reg. No. 1,745,032. (copy attached as exhibit A).

2- Registrant is doing business as LUCRECE Physicians Aesthetic Research, and have [sic] a Trademark Reg. No. 1,868,806 under the [name] of Physicians['] Aesthetic Research. (Registrant [so] admits in the answer to petition to cancel in Paragraph #1) (copy attached as exhibit ... B).

3- Registrant as part of their marketing and advertisement of their product as LUCRECE, [h]as the word permanently displayed on their packaging of the bottles. (Exhibit ... C [of] their advertising--admitted to by registrant on [sic] Paragraph #2 of the answer to petition to cancel).

We observe, however, that Exhibit A is not a status and title copy of the registration which petitioner states that it owns. Instead, as indicated earlier (see footnote 3), such exhibit consists of a printout from an unspecified data base of the "Trademark Registration File" for Reg. No. 1,745,032, which pertains to the mark "LUCRECIA" for "perfume and cosmetic preparations for the care of the skin; namely, lotions, creams,

face powder, lipstick, eye make-up, rouge, and cosmetic soap".<sup>7</sup> Exhibit A also shows that Reg. No. 1,745,032 issued to and is owned by "BISSADA, MOFID" rather than petitioner, Lucrecia.

Exhibit B, we note, is a copy of the first page of respondent's answer to the cancellation petition in which respondent, as previously detailed in this opinion, admits the allegations set forth in the first numbered paragraph of the petition (i.e., that it "persistently uses the name 'Lucrece' on their product label name as an identification of the brand in lieu of: PHYSICIANS['] AESTHETIC RESEARCH LUCRECE") and admits that "copies of documents purporting to be product advertisements were appended to the Petition to Cancel."

Lastly, Exhibit C is a copy of the document attached to the answer. It consists of a piece of product literature bearing respondent's name and shows use of its "LUCRÈCE" and design mark on the packaging (bottles) for its skin care products. The skin care products illustrated in such literature are various facial creams, facial cleaners and body moisture creams.

Turning first to the question of whether petitioner has proven its standing to seek cancellation of respondent's registration, it would be sufficient for such purpose if petitioner were to demonstrate, for example, that it owns a registration for its "LUCRECIA" mark for perfume and certain

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<sup>7</sup> According to Exhibit A, such registration issued on January 5, 1993 from an intent-to-use application filed on April 22, 1991, and sets forth a date of first use anywhere of July 1, 1992 and a date of first use in commerce of August 5, 1992.

cosmetic skin care preparations and that it possess the belief, which is not wholly without merit, that use of respondent's "LUCRÈCE" and design mark for its skin care products is likely, due to the prominence of the term "LUCRÈCE" in such mark, to cause confusion with petitioner's "LUCRECIA" mark for its goods. See, e.g., Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). The evidence submitted by petitioner, however, shows on the face thereof that Reg. No. 1,745,032 is owned by an individual, Mofid Bissada, rather than petitioner, Lucrecia. Moreover, while we observe that the petition for cancellation, like each of the briefs submitted on petitioner's behalf, is signed by "Mofid Bissada - Owner," there is no proof that such individual, as of the close of the trial (testimony periods) in this proceeding, is the owner of petitioner. Furthermore, although such fact has not been proven, we note that even if "Lucrecia" is simply the assumed business name of a sole proprietorship "owned" and operated by Mofid Bissada, so that the caption of this proceeding consequently could be amended to set forth "Mofid Bissada, doing business as Lucrecia," as the name of the petitioner herein, it is still the case, as pointed out by respondent in its brief, that "[p]etitioner has not shown by competent evidence that he [has] proprietary rights to the mark" since there is no proof that the registration for the mark "LUCRECIA" is subsisting.<sup>8</sup> Petitioner,

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<sup>8</sup> As the Board stated in Beech Aircraft Corp. v. Lightning Aircraft Co. Inc., 1 USPQ2d 1290, 1293 (TTAB 1986): "[W]e do not take judicial notice of ... registration files that reside in the Patent and Trademark Office on the basis of their mere identification in

therefore, has failed to establish the requisite standing to bring this proceeding.

Aside therefrom, petitioner has in any event failed to demonstrate that respondent has abandoned the "LUCRÈCE" and design mark. Section 45 of the Trademark Act includes a definition of "abandonment" which states, in relevant part, that "[a] mark shall be deemed to be 'abandoned' when ... the following occurs:"<sup>9</sup>

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume use may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of that mark made in the ordinary course of trade and not made merely to reserve a right in a mark.

It is settled that "[a]bandonment, being in the nature of a forfeiture, must be strictly proved." *Wallpaper Manufacturers, Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 214 USPQ 327, 332 (CCPA 1982). Moreover, as the party seeking cancellation, it is petitioner, rather than respondent, who bears the ultimate burden of proof of abandonment by a preponderance of the evidence. See *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892

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briefs, pleadings, and evidentiary submissions. *See In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974)."

<sup>9</sup> While we note that, as of January 1, 1996, Section 45 of the Trademark Act was amended to provide that a period of three consecutive years of nonuse, instead of a two-year period, constitutes prima facie abandonment, we have applied the two-year standard, since this proceeding was commenced prior to January 1, 1996, so as not to give retroactive effect to the statutory amendment. See *Clairol Inc. v. Compagnie D'Editions et de Propagande du Journal La Vie Claire-Cevic*, 24 USPQ2d 1224, 1226 (TTAB 1992).

F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989). Thus, in order to prevail herein, petitioner bears the burden of establishing at least a prima facie case of abandonment on the basis of nonuse of the "LUCRÈCE" and design mark by respondent for a period of two consecutive years. It is only upon such a showing that the burden of persuasion shifts to respondent to come forward with evidence to disprove the presumption of abandonment. Id. at 1312.

Here, none of the evidence presented establishes a period of two consecutive years of nonuse, which would constitute a prima facie case, nor does it otherwise demonstrate that respondent has abandoned its "LUCRÈCE" and design mark by ceasing the use thereof with an intent not to resume use. Respondent's admission in its answer that it "persistently uses the name 'Lucrece'" on its "product label name as an identification of the brand in lieu of: PHYSICIANS['] AESTHETIC RESEARCH LUCRECE" does not constitute an admission that it has ceased all use of its "LUCRÈCE" and design mark in connection with its goods, nor does it establish, at a minimum, that there has been a two-year period of nonuse of such mark. In any event, respondent's product literature, which was made of record by petitioner,<sup>10</sup> clearly

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<sup>10</sup> Such literature was originally submitted as Exhibit A to respondent's answer, which alleges in the sixth numbered paragraph thereof that: "All products sold by Physicians' Aesthetic Research, Inc. includes [sic] the registered mark imprinted on bottles as exhibited in the attached product description, see Exhibit 'A'." Although, as a general rule, Trademark Rule 2.122(c) provides (with an exception which is not relevant hereto) that "an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony," petitioner's introduction into the record of Exhibit A to

shows use by respondent of its "LUCRÈCE" and design mark in connection with the goods set forth in its involved registration.<sup>11</sup> The pertinent portion of such literature, which depicts use of respondent's registered mark on the bottles for its goods, is reproduced below:



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respondent's answer permits respondent to rely on such exhibit as evidence in its behalf. This is because once evidence has been properly introduced (such as by stipulation), it may be relied upon by either party for any proper purpose.

<sup>11</sup> Petitioner, it appears, is under the impression that a party cannot use a mark except in the format in which it is actually registered. Such, however, is not the case.

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Petitioner has accordingly failed to satisfy its burden of proof that respondent has abandoned its "LUCRÈCE" and design mark.

**Decision:** The petition for cancellation is denied.

J. D. Sams

T. J. Quinn

G. D. Hohein  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board